

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Date: September 8, 2003

Richard Bryan Sagar

Examiner: Stephen D'Agosta

Serial No.: 09/464,866

Art Unit: 2684

Filed: December 16, 1999

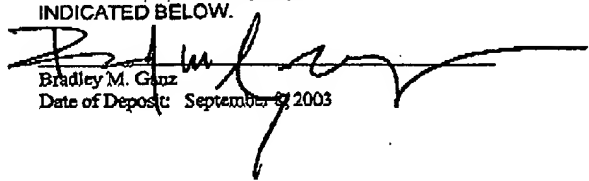
Atty Docket No.: PHA-23.884

For: SHARED ADDRESS-DATA SERVICE
FOR PERSONAL CE-EQUIPMENT

CERTIFICATE OF FACSIMILE

Assistant Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Attn: Examiner Stephen D'Agosta

I HEREBY CERTIFY THAT THIS CORRESPONDENCE
IS BEING SENT VIA FACSIMILE TO THE US PATENT
OFFICE TO EXAMINER STEPHEN M. D'AGOSTA AT
FACSIMILE NUMBER (703) 872-9315 ON THE DATE
INDICATED BELOW.


Bradley M. Ganz

Date of Deposit: September 8, 2003

BRIEF BEFORE THE BOARD OF APPEALS

This is an appeal from a Final Rejection dated May 6, 2003. A Notice of Appeal was received by the Patent Office on June 16, 2003.

REAL PARTY IN INTEREST

The real party in interest is Philips Electronics North America Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-15 remain in the application and are presented in attached Appendix A.
No claims are allowed.

Page 1 of 16 BRIEF BEFORE THE BOARD OF APPEALS
Serial No. 09/464,866

Claims 1-15 stand as finally rejected under 35 U.S.C. 103(a) as being unpatentable over Alley et al. (U.S. Patent 5,845,282) further in view of Nishino (U.S. Patent 6,233,452) and Microsoft Windows and Kato (U.S. Patent 6,088,730) and Park (GB/2325064).

STATUS OF AMENDMENTS

Amendments to claims 1, 2, 8, and 10 were made in Applicant's Response to the Office Action Dated June 5, 2002. Amendments to claims 1, 8, and 11 were made in Applicant's Response to the Office Action Dated November 26, 2002. Amendments to claims 1, 8, and 11 were made in Applicant's Response to the Office Action Dated January 27, 2003. (The claims in the Appendix contain the amendments.)

The rejections of the claims, for reasons explained below, are clearly erroneous.

SUMMARY OF INVENTION

The present invention is generally directed to a system for synchronizing devices, and more specifically to a system that, among other things, enables devices that are not pre-configured for synchronization with each other to synchronize through an intermediate server. The server provides certain functions that facilitate synchronization, and free of resource-intensive software on either device being synchronized.

ISSUES

1. Whether claims 1-15 would have been unpatentable under 35 USC § 103(a) over Alley et al. (U.S. Patent 5,845,282) further in view of Nishino (U.S. Patent 6,233,452) and Microsoft Windows and Kato (U.S. Patent 6,088,730) and Park (GB/2325064).

GROUPING OF CLAIMS

Claims 1-15 stand alone as being unpatentable over Alley et al. (U.S. Patent 5,845,282) further in view of Nishino (U.S. Patent 6,233,452) and Microsoft Windows and Kato (U.S. Patent 6,088,730) and Park (GB/2325064).

ARGUMENT

The Board should first consider the great lengths taken to construct the rejections of the pending claims—a total of five references have been combined in support of the rejection. The fact that so many references must be used only supports the nonobviousness of the present invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-15 were rejected as obvious in view of Alley as the primary reference, in combination with Nishino, Microsoft Windows, Kato, Park, and supposed common knowledge or assumptions and speculation of the Examiner.

Looking at independent claims 1 and 8, the claimed remote server and associated server functions the Examiner believes are present in Alley are in fact absent. The Alley reference contemplates a system for synchronizing files between a desktop computer and pen-based computer, with each device being preconfigured for the synchronization. Alley contemplates synchronization only between these two classes of devices. The reference does not contemplate synchronization of two devices using a remote server device, as will be demonstrated.

In the final Office Action, as in prior actions, the Examiner cites to Alley, Col. 2, lines 31-34, which refers to a "server program":

In one aspect, the present invention provides a method for transferring data from a first computer system running a server program under a first operating system to a second computer system running a control program under a second operating system, the first and second computer systems being in communication through a communications medium. In one aspect, the present invention provides a method for transferring data from a first computer system running a server program under a first operating system to a second computer system running a control program under a second operating system, the first and second computer systems being in communication through a communications medium.

Alley does not expressly define or otherwise indicate what is meant by "server program". However, the meaning is clear from the following description:

In one embodiment, desktop computer 166 further includes a server program that communicates with software running on the remote pen-based computer. One example of such server software is that sold commercially as "Newton Connection Kit" by Apple Computer, Inc., of Cupertino, Calif. The server program runs under an operating system such as the Macintosh® operating system available from Apple Computer, Inc., of Cupertino, Calif. The pen-based computer runs a control program capable of exchanging data and instructions with the server program on the desktop computer, such as the above-described "Newton Connection Kit" software. The control program would run under an operating system adapted for the pen-based computer, such as the Newton® operating system, also available from Apple Computer.

(Col. 10, lines 9-lines 23.)

From the foregoing, it is clear that the term "server program" relates to a program resident on the desktop computer that directly communicates with the pen-based computer. There is no basis in the foregoing passage or elsewhere in Alley to assume a broader or general meaning for the term "server program," such as in the sense of a Web server in communication with multiple computers. The Summary Of The Invention also negates a broader meaning, describing the problem meant to be overcome by the invention as follows:

[T]he present invention addresses two major short comings of pen-based computers by providing users of these computers greater and more simplified access to the information stored on less mobile desktop systems.

(Col. 2, lines 26-29.)

The Examiner states that "[t]oday, both software programs and servers can be logically co-located and/or distributed...." (Emphasis added.) As an initial matter, Applicant notes that it is clearly erroneous to predicate an obviousness rejection on the state of the art "today", the Examiner must establish what the state of the art was at the time of the invention. 35 USC §103. The Examiner then states that Alley contemplates modifications to the invention and concludes that in view of the state of the art "today", Alley can be modified to have a separate, intermediate server. The Examiner cited Col 14, lines 6-18 for the proposition that the Alley can be so modified. The exact language of that passage reads as follows:

While this invention has been described in terms of several preferred embodiments, there are alterations, permutations, and equivalents which fall within the scope of this invention. It should also be noted that there are many alternative ways of implementing the processes of the present invention. For example, much of the programming can be simplified by using the high-level utilities and data structures mentioned in the preceding specification. In particular, the described frame database system is preferred for simplifying the programming tasks required by the computer implemented processes of the present invention, but there are many other database and graphics systems which can be used to accomplish the same task.

The Examiner is inferring the suggestion for modification from such ubiquitous, general catch-all language. This is inconsistent with the principle that there must be a clear teaching or suggestion to support an obviousness rejection. A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to

establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

In addition to the reasons already given, the proposed modification is clearly erroneous for other reasons. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious). Further, the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The rejection of all claims is clearly erroneous because the rejections are not in accord with the foregoing rules. For example, the Examiner has not identified any reason why the proposed modifications would be desirable. In fact, the proposed modification of the desktop computer of Alley would be contrary to the

objective of Alley of allowing a user of the desktop unit to simply and efficiently synchronize that user's pen-based portable computer with the desktop unit:

The present invention alleviates the above-described limitations of pen-based computers by provided facility for browsing and selecting files stored on a remote desktop computer from a pen-based computer in an intuitive and efficient manner. The present invention further provides for the transfer and optional translation of the selected files, again in a manner that is both intuitive and efficient. Thus, it will be seen that the present invention addresses two major short comings of pen-based computers by providing users of these computers greater and more simplified access to the information stored on less mobile desktop systems.

(Col. 2, lines 19-30; see also, e.g., Col. 1 lines 3-12; Col. 13.)

It would not be desirable, efficient, or cost effective to implement a remote, intermediate server system to merely coordinate synchronizations between the user's pen-based computer and desktop computer for reasons of cost, inefficiency in routing of data; equipment maintenance, etc. In contrast, the intermediate server of the present invention allows synchronizing distribution of data to multiple clients. (Page 2, line 26.) Alley does not contemplate this. The present invention also allows for data conversion so that incompatible devices can communicate. (Page 3-4.) It also allows remote devices to communicate that ordinarily are not configured to communicate without the intermediate server. (Page 4, lines 2-13.) Alley, on the other hand, is directed to two devices pre-configured to communicate with each other. (Col. 9, line 33 to Col. 10, line 8.) Accordingly, the present invention provides many advantages beyond the objectives of Alley.

The claims recite that the first and second apparatuses are remote from each other and from the intermediate server. Because Alley, alone or in combination with any other reference of record, does not teach or suggest the use of first and second apparatuses and an intermediate remote server, no prima facie case of obviousness has been established, and the rejections of all claims 1-15 must be reversed, as all rejections are premised on Alley.

Another deficiency in the rejections based on Alley is the lack of teaching on uploading data to a remote server, as claimed. The Examiner considers Alley to teach uploading to a remote server. However, there can be no such uploading to a remote server because Alley does not teach a remote server that is intermediate first and second apparatuses. The combination of Alley and Nishino is particularly inappropriate because the Nishino reference is non-analogous art related to cellular communication systems. Further, the Examiner has not identified any suggestion for the combination, and persons skilled in the art would not be motivated to combine the complex cellular system of Nishino to synchronize a pen-based computer with a desktop, as taught in Alley, for all the reasons discussed above relative to Alley.

Another deficiency in the rejection based on Alley is the lack of teaching on determining whether the information is a more recent than a copy of the information stored on the remote server. In the final Office action, The Examiner has not identified where in the cited reference(s) this limitation exists. In fact the

Examiner rejects the claims without mentioning this limitation of the claims. Since this limitation has not been shown in the prior art, the rejection should be reversed for at least this reason alone.

Another deficiency in the rejection based on Alley is the lack of teaching on updating the copy of information with the uploaded information, if it is determined that the uploaded information is more recent. The Examiner apparently relies on the combination of Alley with Microsoft My Briefcase, Kato, and Park to arrive at updating. However, the Examiner has not identified any teaching or suggestion in the cited references for the proposed modification of Alley or why it would be desirable. In Kato, the remote server system is used to download data to a PDA through an IR wireless link. The Examiner considers Kato to teach that multiple devices can upload and synchronize data to a web server. However, the Examiner has not cited any passage in Kato where this is described. The rejection should therefore be reversed for this reason. The Examiner's reliance on Kato and Park is also deficient because, as discussed above, it would not be desirable to modify Alley to operate through an intermediate server, and to do so would change Alley's principle of operation. For these reasons alone, the rejections should be reversed.

Another deficiency in the rejection based on Alley is the lack of teaching on manipulating the information on the remote server. The Examiner cites Alley at Col. 2, lines 43-44 as disclosing this manipulation. That passage does not recite

the use of an intermediate, remote server or even mention "server". The file translation referenced in the passage requires a translation application on one of the two devices exchanging information, free of an intermediate server. As noted above in the present application (page 3, line 9 to page 4 line 1), the inclusion of such software on the first or second device has a "software overhead" and efficiencies and other advantages are achieved by the claimed use of an intermediate remote server for hosting a translation application. Accordingly, Alley teaches away from the present invention, and the rejections should be reversed for these reasons alone.

Another deficiency in the rejections based on Alley is the lack of teaching on downloading the manipulated information from the remote server to the second apparatus for storage in a second database of the second apparatus for use in the second apparatus. The Examiner cites Alley at Col. 2, lines 19-44 as disclosing this downloading. That passage does not recite the use of downloading from an intermediate remote server, nor does the passage even mention "server". In the passage, the first apparatus is defined to include the web server program. As noted above, there are inefficiencies and disadvantages to synchronizing a user's pen based computer with desktop using a remote server, Therefore the rejections should be reversed for at least these reasons alone.

Another deficiency in the rejections based on Alley is the lack of teaching on manipulated information automatically being entered and updated into the

second database for use by an application requiring a predetermined data format regardless of the communication compatibility between the first apparatus and the second apparatus. The Examiner has not identified in the cited art any teaching for this limitation that the two apparatuses do not need to be communication compatibility. On the contrary, Alley teaches that the devices are pre-configured to communicate. (Col. 9, line 33 to Col. 10, line 8.) The rejections should be reversed for this reason alone.

Regarding claim 2, the Examiner "assumes that both the hand-held and remote computer can have at least a first and second communications functionalities...." Absent an express teaching for the recited elements, the Examiner's assumptions cannot be used to reject the claims. The Examiner must support the rejections based on what the reference would mean to a person of ordinary skill in the art at the time of the invention or based on inherent features necessarily present in the prior art. The rejection is not premised on either and should be reversed for these reasons alone

Regarding claim 3, the Alley reference is concerned with the synchronization of a pen-based computer with a desktop. In contrast, the Nishino reference relates to infrastructure for cellular systems and is non-analogous art. In any event, the Examiner has not identified any suggestion for the proposed combination of Alley with Nishino. It would be contrary to the objectives of Alley to synchronize the

devices through a cellular infrastructure. For these reasons alone, the rejection should be reversed.

Regarding claim 4, the combination of Alley and Nishino is inappropriate here for the same reasons as given relative for claim 3.

Regarding claim 5, the combination of Alley and Nishino is inappropriate here for the same reasons as given relative for claim 3

Regarding claim 6, the combination of Alley and Nishino is inappropriate here for the same reasons as given relative for claim 3.

Regarding claim 7, the passage cited by the Examiner does not relate the manipulation of information to any particular device or sequence relative to the claimed steps. Therefore the claimed manipulation at the remote server, after upload and before download, is not taught by Alley. Further, Alley does not teach "selective extraction". Nor does the rejection state that the alleged common knowledge existed **at the time of the present invention**. The rejections should be reversed for these reasons alone.

Regarding claim 9, the rejection is inappropriate for the same reasons as given for claim 7.

Regarding claim 10, the rejection is inappropriate for the same reasons as given for claim 2.

Regarding claim 11, the rejection is inappropriate for analogous reasons as given for claims 1 and 8. Further, Alley does not teach two mobile units or the use of common server and the associating of data with a particular user, or the determining of a format, or the converting the format. The Examiner cites Col. 10, lines 38-57 as describing that a specific user is identified by a computer and that access is given only to that user's files. However, that passage does not contain any such description. That passage merely describes that a user may be offered **options** for browsing and retrieving or loading files from a remote computer. The passage does not say that this is a user-specific option, i.e., that that the options would not be the same for every user. Further, the claim recites that data is uploaded to the remote server and then associated with a particular user. The passage cited by the Examiner does not describe these limitations whatsoever. Still further, the Examiner cites Col. 9, lines 64 to Col. 10, line 23 as showing a format desired by a particular user. However, this passage merely describes general communication protocols and does not even discuss data formats, let alone data formats required by a particular user. The rejections should be reversed for any of these reasons alone.

Regarding claims 14, the combination with Nishino is inappropriate for the same reasons given for other claims rejected based on the combination. The rejection should therefore be reversed for this reason alone.

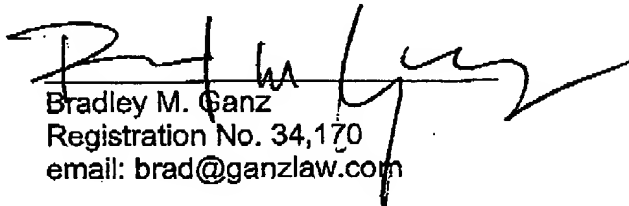
Regarding claim 15, none of the cited references relate to first and second mobile terminals. The proposed modification of Alley to a mobile-to-mobile system with a common server has not been shown to be a desirable modification of Alley. Therefore, there is no teaching, suggestion, or motivation for the combination of cited references. The rejection should be reversed for this reason alone.

In summary, the rejections of independent claims 1, 8 and 11, and the directly or indirectly dependent claims thereto, should be reversed because there are claim limitations not found in the cited references and/or there is no teaching, suggestion, or motivation in the references to combine them in the manner in which they have been combined, leaving the combination as an impermissible hindsight construction of the invention. Applicant incorporates by reference all previous arguments as to non-obviousness.

For one or more of the reasons set forth above, the Board is respectfully requested to reverse the Examiner's rejection of all claims 1-15 and to confirm patentability thereof.

Respectfully submitted,

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Appendix A

1. A method of transferring information in a first database (108) of a first electronic apparatus (102) to a second apparatus (104), comprising

uploading information from a first apparatus to a server that is remote from the first apparatus (106), the information stored in a first database of the first apparatus for use in the first apparatus, and the server accessible by a second apparatus that is remote from the first apparatus and the server;

determining whether the information is more recent than a copy of the information stored on the server;

updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent;

manipulating the information at the server; and

downloading the manipulated information from the server to the second apparatus for storage in a second database (124) of the second apparatus for use in the second apparatus,

wherein the manipulated information can be automatically entered and updated into the second database for use by an application in the second apparatus requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

2. The method of claim 1, wherein:

- the first apparatus performs first communication functionalities using data stored in the first data base; and
- the second apparatus performs second communication functionalities using data stored in the second data base.

3. The method of claim 1, wherein each of the first and second apparatus comprises at least one of the following: a PDA with an Internet capability, a mobile phone, a wired phone, a pager.
4. The method of claim 1, wherein the information is uploaded via the Internet from the first apparatus to the server.
5. The method of claim 1, wherein the information is downloaded via the Internet to the second apparatus.
6. The method of claim 1, wherein the server keeps a copy of the information uploaded.
7. The method of claim 1, wherein the manipulating comprises at least one of the following:
 - selectively extracting data from the uploaded information and converting a format.
8. A method of providing a service for enabling to transfer information in a first database (108) of a first electronic apparatus (102) to a second apparatus (104), comprising:
 - enabling to upload information from a first apparatus to a server that is remote from the first apparatus (106), the information stored in a first database of the first apparatus for use in the first apparatus, and the server accessible by a second apparatus that is remote from the first apparatus and the server;

enabling to determine whether the information is more recent than a copy of the information stored on the server;

updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent;

enabling to manipulate the information at the server; and

enabling to download the manipulated information from the server to the second apparatus for storage in a second database (124) of the second apparatus for use in the second apparatus,

wherein the manipulated information can be automatically entered and updated into the second database for use by an application requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

9. The method of claim 8, wherein the enabling to manipulate comprises at least one of the following: selectively extracting data from the information and converting of a format.

10. The method of claim 8, wherein:

- the first apparatus has a first communications capability based on the first data base;
- the second apparatus has a second communications capability based on the second data base;
- the first data base relates to a first communications directory; and
- the second data base relates to a second communications directory.

11. A method for transferring data in a database of a first mobile terminal to a second mobile terminal, comprising:

providing a common server accessible to a first mobile terminal and a second mobile terminal, the terminals being remote from each other and the server, the first mobile terminal having at least a first application and associated first database for use in the first mobile terminal, and the second mobile terminal having at least a second application and associated second database for use in the second mobile terminal;

uploading data from the first application's first database to the common server;

associating the data with a particular user;

determining a format required by the particular user;

converting the uploaded data to conform to the format;

downloading the converted data automatically into the second database for use by the second application.

12. The method of claim 11, wherein the first database includes a telephone directory.

13. The method of claim 11, wherein the second database includes a telephone directory.

14. The method of claim 11, wherein the first apparatus and the second apparatus includes one or more of a PDA, a pager, and a cellular telephone.

15. The method of claim 1, wherein the manipulated information includes one or more telephone numbers automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus.